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1 **(4) REMARKS**

2
3 RESPONSE TO REJECTION UNDER ACTION PARA. 1

4
5 No response required.

6
7 RESPONSE TO REJECTION UNDER ACTION PARA. 2

8
9 The claims have been amended with respect to the noted informalities. Applicant wishes to
10 thank the Examiner for the clear nature of the objections and the proposed solutions.

11 Withdrawal of the objections is respectfully requested.

12
13 RESPONSE TO REJECTION UNDER ACTION PARA. 3 & 4

14
15 Claims 1-10 were rejected as obvious under Sec. 103(a) in view of U.S. Pat. No. 6,091,409
16 (Dickman hereinafter).

17
18 Independent claim 1 clearly includes: "...one *temporarily* marked location *on said tablet* with a
19 preselected Internet data address wherein *subsequently accessing said marked location* with
20 said stylus triggers a shift to said data address associated with said marked location."
21 Emphases added.

22
23 It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Co. v. Kinkead
24 Indus., 810 F.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793
25 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be
26 considered. DML, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985). By
27 ignoring the present application's use of the claims limitations as discussed in the Detailed
28 Description, the argument as set forth in the Action ignores this requirement. Understanding, or
29 Interpreting, a limitation *already in a claim* in light of the Detailed Description is not the same as
30 an impermissible reading of a limitation into a claim. Otherwise, these court decisions are

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1 rendered meaningless. This need for consideration of "specification language" is particularly
2 applicable in computer process cases where terms carry a special rather than ordinary
3 (dictionary) meaning.

4
5 In general, the Action relies on Dickman's FIGURE 4. Dickman's FIGURE 4 is a known manner
6 computer screen "user interface" (col. 3, ll. 29-31), a virtual desktop 50 with icons 52 (col. 6, ll.
7 40-49). It is like present applicant's FIG. 1 (Prior Art), FIG. 2A, B, as to elements 201, 209.
8 The present application disclosure is on its face not directed to such semi-permanent screen
9 icon implementations.

10
11 The Action further relies on Col. 4, ll. 42-46, of Dickman. It reads:

12 "...Internet shortcuts may be dragged and dropped. The Internet shortcuts encapsulate
13 URLs (or other location information) and other information. The Internet shortcuts are
14 implemented as objects that are visible within the shell name space."

15 These are not freehand drawn spontaneous symbols by the user as taught and claimed in the
16 present application; they are merely known manner fixed icons to fixed sites, shown by
17 Dickman, for example, as "Inbox" or user applications "Shortcut to Ms." There is no
18 spontaneous association as described and claimed in the present application. This is clearly
19 not a "computer annotator system" shown by applicant and claimed as a "system," including a
20 handwriting recognition tablet 205. In fact, the Action admits at Page 3 that "Dickman however
21 does not teach that in an electronic table (sic, tablet) with a marketing (sic, marking) stylus be
22 used with the system."

23
24 There are several specific and significant differences with respect to the problem and solution
25 addressed by Dickman. Dickman's "internet shortcuts" are, by design, persistent rather than
26 temporary. Each of Dickman's shortcuts is implemented as an object that supports a Microsoft
27 Object Linking and Embedding (OLE) interface - - see Col. 7, ll. 39-43 - - intended to provided
28 persistence of stored data objects - screen icons - which do not disappear whenever the user
29 ends a session or logs-out. Such desktop iconic shortcuts are a quick way to access frequently
30 referenced resources. To be effective, such shortcuts point to permanent objects. For

not claimed (1)

(2)

(3) if is not claimed

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1 example, many users have shortcuts which link to frequently used programs such as an e-mail
2 reader or an Internet browser to invoke the whole program. Dickman's Internet shortcuts are
3 iconic links to frequently accessed Internet addresses ("URLs") which are generally sites with
4 well-known URL's, e.g. "Amazon.com." It is not practical to create such shortcuts to a page
5 which disappears as soon as a session is completed, e.g. to an Amazon.com "shopping cart."
6 Thus Dickman's shortcuts are no more relevant than conventional browser bookmarks
7 previously addressed in response to the first Office Action. Long-term referencing is Dickman's
8 goal rather than a transient usage as shown in the exemplary embodiments of the present
9 application.

10
11 To the opposite effect, the present disclosure is to exemplary embodiments which may be
12 optimized for ephemeral URLs such as those encountered during Internet searches where such
13 may be constructed on-the-fly by web servers as needed.

14
15 The rejection should be withdrawn based on this ground alone. However, the Office made other
16 arguments.

17
18 The Office Action also alleges that

19 "It would have been simple to utilize a tablet and stylus as an input manipulation means,
20 . . . because of the extreme conventionality of the input device and its common use as a
21 substitute to the mouse input device."

22 Input manipulation is not sufficient. Dickman's Internet shortcuts use graphical icons to
23 represent the URLs. As a result, Dickman's invention requires an interface that supports both
24 input and output, in particular, an output capability sufficient to do medium resolution graphics to
25 display the icons themselves. Thus, it is not an obvious implementation nor combination to
26 achieve the temporary association described by the present applicant. In any event, nothing in
27 Dickman itself suggests nor motivates such a combination.

28
29 The present disclosure describes and claims a simple digitizer tablet. It is known that such
30 simple digitizing tables operate in either of two mutually exclusive modes: "relative coordinate"

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1 or "absolute coordinate." In the relative coordinate mode, movement of the tablet's stylus is
2 sensed with respect to the stylus' current position - - for example, a stylus movement to the left
3 indicates a leftward movement regardless of where on the table the stylus is resting. A digitizer
4 table operating in a relative coordinate mode would emulate the behavior usually associated
5 with a mouse. To utilize a tablet as a mouse substitute, Dickman would need to use a relative
6 mode. Again, there is no suggestion nor motivation in Dickman itself for such an
7 implementation.

8
9 Moreover, to the contrary, the present invention exploits the absolute coordinate mode
10 capability of a digitizer tablet, claiming "... associating at least on temporarily marked location. .
11 .." Absolute mode is quite different from relative mode; the tablet's stylus position is sensed
12 with respect to the exact location of the stylus on the tablet - - for example, a stylus movement
13 in the upper left corner of the tablet is completely different from a stylus movement in the lower
14 right corner of the tablet. The absolute coordinate system of the tablet enable the described
15 embodiments of the present invention to process the arbitrary mnemonic symbols written at
16 arbitrary locations.

17
18 Again, based on these facts, the rejection should be withdrawn.

19
20 The Action continues in a specific argument that regarding claim 2,

21 "... Dickman teaches a surface region where the annotating function is implemented,
22 namely the shell space or desktop. . . ."

23 Again, this is an extrapolation of the actual language of Dickman which clearly defines the iconic
24 shortcuts as persistent data structures that must be manipulated within the Windows desktop.

25
26 Again, based on this fact, the rejection should be withdrawn.

27
28 The Action continues in a specific argument against claim 3, referring to Dickman's FIG. 9d as
29 having

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1 "...a second region accessible by the input device where an image indicative of the
2 address is entered."

3 Again, this aspect as defined in the present disclosure is not found in the Dickman disclosure.
4 FIG. 9d only shown an Internet shortcut residing within a "Favorites" folder. This "second
5 region" is just a conventional Windows folder, not a temporary association symbol in freehand
6 on a tablet. Since Dickman's shortcuts are Windows objects (Col. 7, ll. 12-14), they can be
7 stored in a folder in the same way that file system icons can be stored in a file folder. This is not
8 the disclosure nor claim of the present invention.

9
10 The Action continues, alleging claims 8-10 are rejected on the same grounds as claims 5-7 and
11 that claims 5-7, 11-15, and 17-20 are rejected per the first Office Action and further addressed
12 in Para. 5 of the Final Office Action, discussed in the next Section hereinbelow.

13
14 In summary, Nothing in Dickman discloses, suggests, nor motivates such the elements and
15 functions as described and claimed in the present invention. In fact, in summary, a given, point-
16 and-click icon fixed on a screen as shown by Dickman, and a staple of Microsoft Windows and
17 other Internet access short devices as mentioned by the Examiner at Page 4, last line, is an
18 opposite concept to such a spontaneous association between an Internet site and a freehand
19 associative symbol. Proceeding contrary to the wisdom of the prior art is "strong evidence" of
20 non-obviousness. W.L. Gore & Assoc., Inc. V. Garlock, 220 USPQ 303 (CA FC 1983).

21
22 Withdrawal of all the rejections is respectfully requested.

23
24 RESPONSE TO REJECTION UNDER ACTION PARA. 5

25
26 Regarding claims 1-3 and 8-10, it is not clear whether the suggestions with respect to Claims 1-
27 3, and 8 in para. 2 of the Action were the recommendations referring to this paragraph.
28 Clarification is respectfully requested. See also, Petition, filed herewith. Moreover, the
29 Remarks with respect to Dickman make it clear that there is clearly a different invention
30 claimed.

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Regarding claims 5-7 rejected under Sec. 102 re: Makino. The Action states,
". . .the claim can still be anticipated by Dickman since it is well known to people skilled
in the art since 1995, that shortcuts are inherently designed to be place in random
locations, erased, and be place over the desktop in random locations."

In In re Newell, 13 USPQ2d 1248, 891 F.2d 899 (Fed. Cir. 1989) the court explicitly stated that:
"[I]n deciding that a novel combination would have been obvious, there must be
supporting teaching in the prior art."; "[A] retrospective view of *inherency* is not a
substitute for some teaching or suggestion which supports the selection and use of the
various elements in the particular claimed combination." (At 1250, emphasis added.)

It is respectfully submitted that the rejection is deficient and should be withdrawn.

Regarding claim 15, the Examiner argues the claimed element
"...computer code for accessing said address. . .highly resembles a macro, a series of
computer code associated to perform a function...anticipated by Dupony (sic, Dupouy)."
The claim must be considered as a whole; applicant claims code where the inter-relationship of
"temporary symbols" recorded by the user can be used to access the Internet site. This is not
shown in the reference. Withdrawal of the rejection is respectfully requested.

Regarding claims 11, 12, and 14, applicant claims: "...associating an address of the site with a
writable-erasable mnemonic device in a computer writing tablet." A reference under Sec. 102
must contain disclosure of such a feature to anticipate the claim. Dupouy has no such element.
Claims 12 and 14 are dependent on independent claim 11. A dependent claim includes all the
limitations of the claim from which it depends and, as such, makes specific that which was
general. 35 USC 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ
849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent
claims are non-obvious if the independent claims from which they depend are non-obvious. In
re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); see a/so Hartness International, Inc. V.
Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re

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1 novelty). Thus, allowance of a base claim as patentable normally results in allowance of a claim
2 dependent upon that claim. Withdrawal of the rejection is respectfully requested.

3
4 SUMMARY AND CONCLUSION

5
6 Applicant has shown specific technical differences above which eliminate all the references
7 cited. Moreover, legal reasons for rejection of each of the references has been raised.
8 Therefore, all grounds for rejection have been overcome.

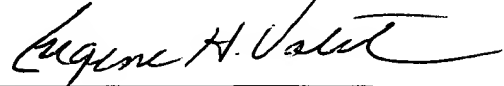
9
10 Based upon the foregoing, it is submitted that the application now presents claims which are
11 directed to novel, unobvious and distinct features of the present invention which are an
12 advancement to the state of the art. Reconsideration and early allowance of all claims is
13 respectfully requested. The right is expressly reserved to reassert any and all arguments,
14 including the raising of new arguments, should a Notice of Allowance not be forthcoming.
15 Applicant reserves the right to reinsert claims and to prosecute claims via continuing and
16 divisional applications.
17

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Questions or suggestions that will advance the case to allowance may be directed to the undersigned by teleconference at the Examiner's convenience.

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Respectfully submitted,
Hewlett-Packard Company



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